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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,342	01/03/2006	Leander Dietzsch	GK-Zei-3280 / 500343.2030	1621
26418	7590	10/19/2006	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			STEPHENS, SCOTT H	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/540,342

Applicant(s)

DIETZSCH ET AL.

Examiner

Scott H. Stephens

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/05</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

Claim 19 is objected to because of the following informalities: Claim 19 appears to contain two periods. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the phrase "and/or" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). For the purposes of examination, examiner will interpret the claim to read "changer device or as an objective focusing device".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-13, 16-19, and 21-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberger (US 4168881).

Regarding claim 12, Rosenberger teaches a microscope comprising: a base body or a stand (12); a stage support (dashed outlined element under element 18); a guide for adjusting the stage support or an objective changer device with inserted objectives (15); and a stage for holding the object or specimen (18); said microscope further comprising: a supporting cell (14) being provided and being connected to the stand (fig. 2), preferably rigidly (col. 2 line 7) but so as to be exchangeable (col. 2 line 64); and a first assembly being provided for receiving, holding and adjusting the objective (32) and a second assembly being provided for positioning the object or specimen relative to the objective (see lower portion of microscope shown in fig. 2 including elements 15, 18, 20, and 22), said first and second assembly are attached to said supporting cell (fig. 2).

Regarding claim 13, Rosenberger further teaches wherein the supporting cell is rigidly fastened to a plurality of projections (16) of the stand.

Regarding claim 16, Rosenberger further teaches wherein the first assembly is designed as an objective changer device (col. 3 lines 12-14) or as an objective focusing device.

Regarding claim 17, Rosenberger further teaches wherein the second assembly comprises a stage support (dashed outlined element under element 18), a stage guide (15), and a stage (18).

Regarding claim 18, Rosenberger further teaches wherein the supporting cell is optimized with respect to rigidity (col. 2 line 7), use of material (col. 2 line 7), dimensioning (col. 2 lines 27-31) and thermal behavior (examiner notes that while

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Rosenberger does not specifically address thermal behavior, it is understood that the supporting cell is sufficiently optimized with respect to thermal properties to allow ideal operation) while adhering to requirements for high stability and imaging quality of the microscope.

Regarding claim 19, Rosenberger further teaches wherein an objective changer device constructed as an objective turret is arranged at the supporting cell (col. 3 lines 12-14 also see fig. 2).

Regarding claim 21, Rosenberger further teaches wherein the stage guide has a guide plate (20 and 22) that is fixedly arranged at the supporting cell and guide elements at the stage support which are in an operative connection with the guide plate.

Regarding claim 22, Rosenberger further teaches wherein the supporting cell comprises a thermally invariant ceramic material, sintered material or other suitable material (col. 2 line 7 and 26-31) or a combination of such materials. Examiner notes that the heavy and rigid material forming Rosenberger's supporting cell qualifies as a "suitable material" thus meeting the limitation of claim 22.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberger (US 4168881) in view of Kanao (US 6594075).

Although Rosenberger teaches vibration reduction as well as screws providing attachment between the base and supporting cell, Rosenberger lacks vibration-isolation intermediate layers between the supporting cell and the contact surfaces of the screws of the stand (i.e. projected portions). Kanao teaches a microscope where vibration-isolation is achieved via a vibration absorber material (col. 14 line 48-50, col. 16 lines 7-10, col. 16 lines 63-65, and fig. 13) which provides a springing attachment (examiner notes that rubber provides a spring-like restorative force). At the time of invention, it would have been obvious to one of ordinary skill in the art to modify Rosenberger's projected portions to include the vibration-isolating intermediate layers taught by Kanao. The motivation for doing this would have been to prevent vibration transmission to the optical system and specimen as suggested by Kanao (col. 16 lines 7-10).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberger (US 4168881) in view of Weiss (US 2003/0133190).

Rosenberger lacks a condenser at the stage support. Weiss teaches a condenser (4) arranged at the stage support (1). At the time of invention, it would have been obvious to one of ordinary skill in the art to modify Rosenberger's stage to include Weiss's condenser. The motivation for doing this would have been to allow illumination to be provided from beneath the sample as suggested by Weiss (paragraph 47).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lewis (US 4917462) teaches a microscope with vibration reduction and intermediate layers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott H. Stephens whose telephone number is 571-272-3113. The examiner can normally be reached on Monday-Friday 7:30am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott Stephens
Monday, October 16, 2006

SHS


MARK A. ROBINSON
PRIMARY EXAMINER